

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANSUKH M. PATEL,
DAVID R. PHILLIPS, III
and CHUNGSEA A. SHEN

Appeal No. 2003-0418
Application No. 09/648,033

ON BRIEF

Before PAK, KRATZ and DELMENDO, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-20, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a chewing gum, a gum base and a method for making a chewing gum. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

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1. A chewing gum comprising:
a water insoluble not including a filler;
a water soluble portion including a flavor; and
approximately 3% to about 15% by weight lecithin.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Klose et al. (Klose)	4,246,286	Jan. 20, 1981
D'Amelia et al. (D'Amelia)	4,452,820	Jun. 5, 1984
Cherukuri et al. (Cherukuri '615)	4,518,615	May 21, 1985
Cherukuri et al. (Cherukuri '003)	4,794,003	Dec. 27, 1988

Claims 1-6 and 14-20 stand rejected under 35 U.S.C. § 102 as being anticipated by Cherukuri '615, Cherukuri '003 or D'Amelia. Claims 8-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cherukuri '615, Cherukuri '003 or D'Amelia. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cherukuri '615, Cherukuri '003 or D'Amelia in view of Klose. Claims 1-20 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-16 of application No. 09/648,028 in view of Cherukuri '615, Cherukuri '003 or D'Amelia. The examiner refers to Paper No. 5 for statements of the rejections (answer, pages 3 and 4.

We reverse the examiner's § 102 rejections and remand the application to the examiner for reasons discussed more fully below.

OPINION

In order for a claimed invention to be anticipated under 35 U.S.C. § 102, all of the elements of the claim must be found in one reference. See Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Each of Cherukuri '615, Cherukuri '003 or D'Amelia relates to chewing gums and chewing gum bases. In numbered paragraph 5 of Paper No. 5, the examiner refers to columns 5 and 6 and Run D of Table III of Cherukuri '615, columns 2 and 6-8 of Cherukuri '003 and columns 3, 5, 6 and 10 of D'Amelia. Cherukuri '615 discloses a chewing gum made from a chewing gum base that includes, inter alia, an emulsifier selected from among a number of listed materials including lecithin fatty acid monoglycerides. The emulsifier that is selected may make up about 2-10 weight percent of the gum base of Cherukuri '615 (column 3, lines 27 and 28), albeit the amount of the type of emulsifier that is selected for the base may make up a lesser weight percent of the gum product including the water soluble sweeteners since the gum base

only constitutes from 5 to 45 weight percent of the gum product. See, e.g., column 6, lines 34-60 of Cherukuri '615. The gum base and gum of Cherukuri '615 may or may not include filler. See, e.g., column 3, line 36 of Cherukuri '615. Similarly, each of Cherukuri '003 or D'Amelia describes gum bases and gums that may or may not include a variety of components, such as lecithin and fillers, in a range of amounts.

To arrive at the appellants' claimed invention based on the teachings of Cherukuri '615, Cherukuri '003 or D'Amelia, one must choose to use lecithin from among a number of alternatives disclosed in each of those references, choose to employ no filler, and choose to employ an amount of lecithin and an amount of other gum ingredients, including the ingredients that are not part of the gum base, such that the total amount of the lecithin chosen would correspond to the claimed amount. While some picking and choosing may be entirely proper in making an obviousness rejection under Section 103, it has no place in making a Section 102 rejection for anticipation. In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972). Accordingly, on this record, we reverse the rejections under 35 U.S.C. § 102.

REMAND

As we indicated above, that some selection may be required to arrive at the claimed subject matter from the teachings of the applied prior art is not, of itself, fatal to a properly fashioned § 103 rejection. Unfortunately, the examiner's § 103 rejection of claim 7 implicitly relies on the examiner's improper analysis and conclusion that the subject matter of claim 1, which is incorporated in claim 7 by virtue of its dependency thereon, was anticipated by Cherukuri '615, Cherukuri '003 or D'Amelia. Consequently, that rejection is not ripe for review, at this time.

Moreover, it is not clear, at this time, whether or not the examiner's separate § 103 rejection of claims 8-13 is also infected with that incorrect analysis of the teachings of the applied references. Accordingly, that rejection is not ripe for review, at this time.

In addition, we note that PTO records that are available to us indicate that application No. 09/648,028 currently enjoys abandoned status, a status that was in effect more than six months prior to the time the examiner mailed the examiner's answer. Consequently, we decline to review the examiner's obviousness-type double patenting rejection over claims 1-16 of

application No. 09/648,028 in view of Cherukuri '615, Cherukuri '003 or D'Amelia, a rejection that is moot at this time. The examiner should determine whether any continuing applications of 09/648,028 are currently pending, and whether or not a provisional obviousness-type double patenting rejection should be entered over the claims of any such continuing application.

In light of the above discussion, we remand the application to the examiner to consider whether or not Cherukuri '615, Cherukuri '003 or D'Amelia alone or in combination with any other prior art would have rendered any or all of the claimed subject matter obvious within the meaning of 35 U.S.C. § 103.

We note that it is important that the examiner conducts a complete examination of the claimed subject matter with respect to prior art references that are found to be particularly relevant according to the examiner not only under 35 U.S.C. § 102 but also under 35 U.S.C. § 103. For example, where overlapping ranges and some selection are involved, as is the case here, the examiner should consider the unpatentability of the claims under § 103.

We strongly encourage the examiner to determine whether or not prosecution should be reopened to introduce a rejection of any of appellants' claims 1-6 and 14-20 under 35 U.S.C. § 103

over Cherukuri '615, Cherukuri '003 or D'Amelia alone or in combination with any other pertinent prior art that the examiner may find or be aware of so that examination of appellants' claims is not conducted on a piecemeal basis. The examiner should also reconsider the separate § 103 rejections of claim 7 and claims 8-13, in view of that determination and, if such a rejection is to be maintained, provide an appropriate analysis under the guidelines for a proper § 103 rejection as set forth in the Manual of Patent Examiner Procedure (MPEP) for each separate claim. See, e.g. MPEP § 706.02(j) (8th ed., Aug. 2001).

For the foregoing reasons, the decision of the examiner is reversed as to all of the rejections based upon 35 U.S.C. § 102, and the application is being remanded to the examiner for appropriate action in view of our comments above.

We emphasize that the subject application is being returned to the jurisdiction of the examiner for taking appropriate action consistent with the above in light of current examining practice and procedures. A supplemental answer would not appear to effect the requisite clarification that is necessary to respond to this Remand. Consequently, we do not authorize a supplemental examiner's answer as an appropriate response to this Remand.

REVERSED-IN-PART/REMANDED

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AND
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Appeal No. 2003-0418
Application No. 09/648,033

Page 9

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